

PUBLIC VERSION

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

ETHICON LLC,
Patent Owner.

Case IPR2019-00880
Patent 7,490,749

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION1

II. CLAIM CONSTRUCTION1

III. ARGUMENT.....1

A. The Challenged Claims Are Anticipated (Grounds 1-3).....1

 1. Ground 1: Shelton II Anticipates Because a POSITA Would Have Immediately Envisioned Removal of the Retraction Spring1

 2. Grounds 1-2: Shelton II and Swayze Each Anticipate When the Retraction Spring is Disconnected8

 3. Ground 3: Shelton I Anticipates Under Ethicon’s Non-112(6) Constructions.....12

B. The Challenged Claims Are Obvious (Grounds 1-2)12

 1. The Petition Provides Ample Motivation to Remove the Retraction Spring of Shelton II and Swayze12

 2. Removing the Retraction Spring Leaves the Fundamental Principles of Operation Unchanged17

 3. Conventional Wisdom Supports Obviousness18

 4. Ethicon Conflates Obviousness and Bodily Incorporation18

C. Ethicon Cannot Swear Behind The Prior Art20

 [REDACTED]20

 [REDACTED]24

IV. CONCLUSION.....25

EXHIBITS

- IS1001 U.S. Patent No. 7,490,749 to Schall, et al. (“’749 Patent”)
- IS1002 Excerpts from the Prosecution History of the ’749 Patent (“the Prosecution History”)¹
- IS1003 Declaration of Dr. Knodel, including Curriculum Vitae
- IS1004 US Patent Publication No. 2006/0175375 (“Shelton II”)
- IS1005 US Patent Publication No. 2005/0178813 (“Swayze”)
- IS1006 US Patent No. 8,322,455 (“Shelton I”)
- IS1007 Complaint for Patent Infringement, *Ethicon LLC, et al. v. Intuitive Surgical, Inc., et al.*, Case No. 1:18-cv-01325 (D. Del. Aug. 27, 2018)
- IS1008 How Design Teams Use DFM/A to Lower Costs and Speed Products to Market (1996) (retrieved from http://www.ame.org/sites/default/files/target_articles/96q1a2.pdf)
- IS1009 Electronic Comparison of Written Description of Swayze (US 2005/0178813; Original) to Shelton II (US 2006/0175375; Underline/Strikethrough)
- IS1010 U.S. Patent No. 5,941,442
- IS1011 U.S. Patent No. 5,865,361
- IS1012 Excerpts from McGraw-Hill Dictionary of Scientific and Technical Terms (6th Edition, 2003)

¹ Copies of foreign patent references removed.

PUBLIC VERSION

Proceeding No. IPR2019-00880
Attorney Docket No. 11030-0052IP1

IS1013 Declaration of Victoria Salimov (*Served*)

IS1014 Declaration of Jacob Munford (*Served*)

IS1015 Transcript of Remote Deposition of Dr. Shorya Awtar dated April 7, 2020²

IS1016 US Patent Publication No. 2005/0263562

IS1017 US Patent No. 5,865,361

IS1018 US Patent Publication No. 2005/0279804

IS1019 International Publication No. WO 03/030743

IS1020 LAPAROSCOPIC VASCULAR CONTROL TECHNIQUES IN DONOR NEPHRECTOMY: EFFECTS ON VESSEL LENGTH (Bernie *et al.*)

IS1021 US Patent Publication No. 2005/0006432

IS1022 US Patent No. 5,485,952

IS1023 US Patent No. 6,988,649

IS1024 US Patent No. 5,383,880

IS1025 US Patent Publication No. 2007/0175959

IS1026 *In the Matter of Certain Reload Cartridges for Laparoscopic Surgical Staplers*, Inv. No. 337-TA-1167, Ethicon's Infringement Claim Chart for U.S. Patent No. 7,490,749

² While the document is marked "SUBJECT TO PROTECTIVE ORDER," the parties subsequently agreed that no redactions are necessary.

PUBLIC VERSION

Proceeding No. IPR2019-00880
Attorney Docket No. 11030-0052IP1

- IS1027 SureForm60, Stapler User Manual (Instruments and Accessories User Manual Addendum)
- IS1028 *In the Matter of Certain Reload Cartridges for Laparoscopic Surgical Staplers*, Inv. No. 337-TA-1167, Ethicon's Opening Claim Construction Brief
- IS1029 Supplemental Declaration of Dr. Knodel
- IS1030 Echelon 60 Endopath Stapler Product Sheet, available at https://www.medexsupply.com/images/07-0743_EC60ProdSheet.pdf

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.